

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ferguson et al.
Title: USE OF CONVERTASE INHIBITORS...
Appl. No.: 10/522,222
Filing Date: 1/24/2005
Examiner: Gudibande
Art Unit: 1654
Conf. No.: 1601

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent application.

The Patent Office determined that the patent was entitled to 0 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 240 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 499 days

(b) Total Applicant delay: 259 days

Final PTA Determination: 240 days

Applicants therefore respectfully request that the patent be accorded 240 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date November 5, 2009

By 

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 094712-0103

Application Number: 10/522222

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	07/24/2002	-915		
Edit Delete	International Filing Date	07/23/2003	-551		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	01/24/2005	0		
	PCT National Stage Commencement Date	01/24/2005	0		
	14 month From Application date	03/24/2006	424		
Edit Delete	Restriction Requirement	12/11/2006	686	262	
	Restriction Requirement + 3 months	03/11/2007	776		
Edit Delete	Restriction Requirement Response Received at PTO	04/16/2007	812		36
Edit Delete	Non-Final Office Action	06/22/2007	879		
	Non-Final Office Action + 3 months	09/22/2007	971		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/21/2007	1,061		90
	3 Year Period Starts	01/24/2008	1,095		
Edit Delete	Final Office Action	03/18/2008	1,149		
	Final Office Action + 3 months	06/18/2008	1,241		
Edit Delete	Final Office Action Response Received at PTO	08/05/2008	1,289		48
Edit Delete	Advisory Action	09/04/2008	1,319		
Edit Delete	Request For Continued Examination (no amendment)	09/17/2008	1,332	237	
Edit Delete	Non-Final Office Action	11/26/2008	1,402		
	Non-Final Office Action + 3 months	02/26/2009	1,494		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	05/22/2009	1,579		85
Edit Delete	Notice of Allowance	08/06/2009	1,655		
	Projected Patent Grant Date	02/16/2010	1,849		
			Totals:	499	259
			PTA:	240	

discrepancy
with PTO's
calculation

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LOGIN: **Dexter Forbes**

IP: 10.14.51.214

Foley & Lardner LLP